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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,950	12/06/2000	Michiteru Kodama	826.1640/JDH	6943
21171	7590	07/12/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,950

Applicant(s)

KODAMA ET AL.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 15 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 15 claims a discounted trade price calculated based on trade amounts of a past specific period; this language does not further limit this concept already recited in Claim 14.

Claim 16 claims that a trade amount considered in discounting is for a past specific period, a concept already recited in Claim 14.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each Claim recites the phrase "providing a place"; it is unclear how the electronic purchase system, method or storage media would provide a place.

Claim 2 recites the phrase "sales-related information is set." It is unclear what would constitute setting such information.

Claim 6, 10 and 13 recite the phrase "sales-related information about a commodity that the seller offers and is individually set." It is unclear what would constitute setting such

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information or what is set. Claim 13 further recites “sales-related information about a commodity that the seller offers and is individually set for at least of the purchasers from the purchaser”. The meaning of this phrasing is unclear.

Claim 12 recites “ to performing a method comprising:...for registering at least...”. It appears that the word “for’ is extraneous.

The Claims have been examined to the best of the Examiner’s ability given the condition of the Claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,842,178 *Giovannoli*.

As to Claim 1, *Giovannoli* discloses the invention as claimed, including in an electronic purchase system for providing a site where a seller and participate (Abstract), comprising:

a storage unit storing sales-related information about a commodity that the seller offers (Fig. 4, “Product Database”; Col. 4, lines 43-52);

a purchaser registration unit registering one or more purchasers of the plurality of purchasers (Fig. 3, second box ; Col. 4, lines 53-63); and

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a publication unit making public the sales-related information to purchasers registered by said purchaser registration unit (Fig. 4., "Central Office"; Fig. 3, second box; Col. 6, line 64 to Col. 7, line 2).

In the treatment of this Claim and those below, "registration" is understood as the process disclosed by *Giovannoli* of filter specification by purchasers or sellers to select appropriate trading counter parties. Additionally, the receipt by the RFQ network of user e-mail addresses as disclosed by *Giovannoli* would constitute registration.

Concerning Claim 2, *Giovanni* discloses that sales-related information is selected from a potential purchaser at Col. 5, lines 15-18. In this instance, sales-related information is set by the seller to either be received by a purchaser or not received.

With respect to Claim 4, *Giovannoli* discloses the invention as claimed, including in an electronic purchase system for providing a site where a purchaser and a plurality of sellers participate, comprising:

a seller registration unit registering at least one of the sellers (Fig. 3, first box., Col. 7, lines 20-24;

a reception unit receiving a request related to a trade of a commodity from the purchaser (Summary of the Invention, Col. 7, lines 35-52); and

a publication unit making public the request only to sellers registered by said seller registration unit (Col. 7, lines 3-21).

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Concerning Claim 6, see the discussion of Claim 1 and *Giovannoli* further discloses “setting” of salable commodities for purchasers at Col. 7, lines 20-25 and lines 35-56.

With respect to Claim 8, see the discussion of Claim 1 and *Giovannoli* further discloses registering purchasers according to instruction from seller at Col. 7, lines 20-25 and lines 35-56.

As to Claim 9, it is the method form of Claim 4 and is rejected in a like manner.

With respect to Claim 10, see the discussion of Claims 8 and 2.

As to Claim 11, see the discussion of Claim 8; *Giovannoli* further discloses a stored program executed by a computer to perform the method at Col. Col. 4, lines 4-52.

As to Claim 12, see the discussion of Claim 4 and *Giovannoli* further discloses registering sellers according to a purchaser instruction at Col. 7, lines 5-7. See also *Giovannoli* at Col. 7, lines 6-9 regarding commodity trade requests. *Giovannoli* further discloses a stored program executed by a computer to perform the method at Col. Col. 4, lines 4-52.

As to Claim 13, see the discussion of Claim 6 and *Giovannoli* further discloses a stored program executed by a computer to perform the method at Col. Col. 4, lines 4-52.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 3, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,842,178 *Giovannoli*.

Concerning Claim 3, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Giovannoli* does not specifically disclose that purchaser registration information is updated based on a trade between a purchaser and a seller. Official Notice is taken that it was old and well known to update such information based on completed trades. For instance, the updating of accounts receivable from a purchaser upon a sale is fundamental to accounting practice for sales revenues. Establishing such receivables accounts would be essential an essential component of "registering" a purchaser. The Examiner makes this statement having been employed in accounting for nine years.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Giovannoli* to update purchaser registration/receivables information at sale because this would have maintained accurate and timely accounting records.

Concerning Claim 5, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Giovannoli* does not specifically disclose that seller registration information is updated based on a trade between a purchaser and a seller. Official Notice is taken that it was old and well known to update such information based on completed trades. For instance, the updating of available inventory of a seller upon a sale is fundamental to accounting practice for inventory. Determining that a seller had inventory and could supply product would be essential an essential component of "registering" a seller. The Examiner makes this statement having been employed in accounting for nine years.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Giovannoli* to update seller registration/inventory information at sale because this would have maintained accurate and timely accounting records and assured that the seller continued to meet purchaser filter requirements.

As to Claim 7, see the discussions of Claims 6 and 5.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,842,178 *Giovannoli* in view of US 6,078,897 *Rubin et al.*

With respect to Claims 14-16, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Giovannoli* does not specifically disclose that a trade price is discounted based on a total trade amount for a past specific period. *Rubin* discloses this limitation at Col. 7, lines 17-22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Giovannoli* to discount trade prices using a total trade amount for a past specific period because this would encourage purchasers remain loyal to a particular seller and to “buy more and save more”, as is frequently announced in advertising for sales offerings. The same reasoning applies to Claims 15 and 16 as to claim 14, as they are not further limiting.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
July 1, 2004

Examiner Charles Kyle

A handwritten signature in cursive script, appearing to read "Charles Kyle", with a stylized flourish at the end.